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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: APECS INVESTMENT CASTINGS PTY. LTD.) Examiner: SHEEHAN, J.
Serial Number: 08637802) Art Unit: 1742
Filed: 5/8/96)
For: SILVER ALLOY COMPOSITIONS)
Docket Number: 4999)

REPLY TO EXAMINER'S ANSWER

Hon. Commissioner of Patents
And Trademarks
Washington, D.C. 20231

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March 19, 2001

Sir:

This is in response to the Examiner's Answer dated January 17, 2001.

With reference to page 7, second paragraph of the Examiner's Answer, the Examiner provides that there is considerable overlap between the instantly claimed germanium content and that taught by *Rateau*. We would submit that in fact there is a limited overlap, and that in any case the applicant is claiming a selection of alloys having properties that are not a feature of the *Rateau* alloys.

With reference to the Examiner's Response to Appellant's other Arguments commencing on page 8, the applicant considers that the evidence filed to date is objective evidence of superior and improved properties of the APECS alloy the subject of the claims.

noted
JPH
5-22-01

With reference to page 11, (I), the applicant submits that the claims define a single invention since the examiner has not maintained an election requirement and that the alloys sold, being in accordance with claim 7 and claim 8, are proper evidence of use of an embodiment of the invention. It is submitted that it is not incumbent to make all possible embodiments in support of his invention. Where the selection of alloys encompassed by all of the claims is found to lack utility, then this may give rise to invalidity of the broadest claims which include inutile alloys. However, the same claim is not invalid only for the fact that the applicant does not make his profits of a putative alloy within the scope.

With reference to page 9, the middle section, the complex and unpredictable nature is a matter of common general knowledge to persons skilled in the art. We refer to the standard text Alloys and Their Industrial Applications by E.F. Law 3rd edition, published Charles Griffin and Co, London 1917.

"The influence of an added metal on the mechanical properties of a metal or alloy depends on

- (a) the condition in which it exists. i.e. whether it remains free or enters into chemical combination,
- (b) the shape or form it assumes, and
- (c) its volume.

In the analysis of nearly all materials it has long been recognized that a simple statement of the percentage of the elements present is not sufficient, but that it is necessary to go a step further and determine the condition in which these elements occur... it is not the ultimate components but the constituents which govern the mechanical and physical properties of an alloy."

Regarding page 11, (III), the success of the Apecs sterling silver alloys for United Precious Metals is confirmed by the following history.

As a large industry player in the supply of silver alloys to the USA market, the company chooses to sell, at a premium price, the Apecs sterling silver alloys, for which it is liable to pay royalties. If there were no demand for such a product a company of United Precious Metal Refining's standing would not willingly choose to sacrifice margins. See declaration of M. Bernhard on the sales figures which apply to the Apecs sterling silver alloys.

Regarding page 11, (IV), the applicant submits that commercial success of the alloy is derived from the claimed invention, especially as claimed in claims 7 and 8.

Regarding page 13 (I), the Examiner has already acknowledged the nexus between the APECS sterling silver alloy and the alloys of the subject claims. If this is admitted, then there is little need to do it twice. However, the applicant submits that Eccles' evidence is probative.

Regarding page 13(II) and (III), persons skilled in the art were working to solve the problem. It is on the face of a nonsense to allege that these persons, being the officer of the third-party notifier in Europe and the inventor of the cited reference respectively, did not know of the problem at least as far back as 1991 and were not working on the problem.

Regarding page 13, (IV), the applicant would submit that the declaratory evidence is sufficient, and the above data in any case supports it, as does Bernhard.

Further, regarding page 13, (IV), the fact that it is the claimed alloy, at least by claims 7 and 8 is admitted by the Examiner.

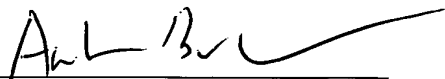
Regarding page 14, (I), this is dealt with satisfactorily elsewhere.

Regarding page 14, (II), the applicant advises that the license is exclusive. However, the exclusivity of the license is of itself not to be dismissive in respect of Bernhard's declaration and the evidence it contains. The reason is to be found in the sales figures, wherein there is little motive for a market leader in all types of sterling silver to pay royalties in respect of one type. The applicant submits that the Bernhard declaration is of probative weight.

Regarding page 15, (III), it is already admitted that the materials referred to as APECS Sterling Silver Alloy is the alloy of the claimed invention insofar as at least claims 7 and 8 are concerned.

Regarding page 16, the applicant understands that all documents being statements necessary to be sworn were dealt with properly. The Examiner at no earlier time brought the issue of inadequate swearing to the attention of the applicant. The applicant submits that the Examiner is estopped from raising a matter of formality of the documents in what is now a de facto adversarial role when the opportunity to do so in an inquisitorial capacity was passed up.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on March 19, 2001.


Sharon Stoffa